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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,293	08/22/2000	JONATHAN A COOPER	14538A-004010US	3432
7590 07/22/2004			EXAMINER	
N POOR TOWENSEND AND TOWNSEND AND CREW 2 EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111			GEBREYESUS, KAGNEW H	
			ART UNIT	PAPER NUMBER
			1652	
DATE MAILED: 07/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/486,293	Applicant(s) COOPER ET AL.	
	Examiner Kagnew H Gebreyesus	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Group I, claims 1-18 are drawn to DNA encoding mammalian Dabl disabled protein 1, or a fragment thereof, vectors, host cells and processes of preparation.
- II. Group II, claims 19-22 are drawn to mammalian disabled protein 1 or a fragment thereof.
- III. Group III, claims 23-32 are drawn to antibodies and binding partners able to bind to the mammalian disabled protein 1.
- IV. Group IV, claims 33 and 34 are drawn to a method of detecting the presence of, predisposition to develop, a mammalian associated protein 1 associated disease in a subject.
- V. Group V, claim 35 is drawn to a method of screening for a compound that modulates either the level of expression of mammalian disabled protein 1 or the affinity of the mammalian disabled protein 1 to binding partners (Src, Abl, Fyn).

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For each of inventions of Groups I – V above, restriction to one of the following is also required under 35 USC 121 and 372. Therefore, election is required of one of inventions of Groups I - V and one of (A) - (C).

(A) Protein of SEQ ID NO. 3 or a nucleic acid encoding the SEQ ID NO 3.

(B) Protein of SEQ ID NO. 5 or a nucleic acid encoding the SEQ ID NO 5.

(C) Protein of SEQ ID NO. 7 or a nucleic acid encoding the SEQ ID NO 7.

The inventions listed as Groups I(A) –V(C) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCR Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The polynucleotides as claimed in Group I and the proteins in Group II and the antibodies in Group III are each unrelated and chemically distinct entities. The only shared technical feature of these groups is that they all relate to nucleic acids encoding disabled protein 1 (Dab1). However this technical feature is not a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art. The following references each teach about the *mdab1* gene: Ware LM et. al., Neuron Vol.19, (239-249) "Aberrent Splicing of a mouse disabled Homolog, *mdab1*, in the scrambler mouse" and Gertler et. al., reference BH of applicants IDS of 02/22/00 as well as Brian W. H. et. al., reference DV all teach the *mDab1* gene from various organisms including mammalian *mDab1* from mouse.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirements be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently inventors is no longer an inventor of at least one claim remaining in the application. Any amendment to inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kagnew H Gebreyesus whose telephone number is 571-272-2937. The examiner can normally be reached on 8:30am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Achutamurthy ponnathapura can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kagnew Gebreyesus
Art Unit 1652

Rebecca L. Pridemore
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GROUP 1652
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